

REMARKS

Applicants respectfully request that the foregoing amendments be made prior to substantive examination of the present application.

Claim Amendments

Claim 24 is amended to recite specific embodiments, e.g., to recite methods of modifying a plant phenotype of a plant grown under normal oxygen conditions. These embodiments are consistent with claims 26 and 27, and are supported throughout the specification as filed and illustrated in the examples.

A Claims Correspondence Table as required for PPH applications is provided below, showing the correspondence between the claims as amended herein and the claims granted in the EPO application:

Claims in U.S. Application	Patentable Claims in EPO Application	Explanation of correspondence
24	1	Differs in current amendment to preamble of U.S. claim and previous correction of clerical error in last paragraph
25	2	
26	3	
27	4	
28	5	
29	6	
30	7	
31	8	
32	9	

Thus, all of the claims pending in the U.S. application sufficiently correspond to the granted EPO claims to participate in the PPH. Upon entry of these amendments, claims 24-32 will remain pending and are presented for examination.

Response to Restriction Requirement

As noted above, in response to the restriction between (I) methods comprising transforming a plant to increase the level of expression of non-symbiotic hemoglobin and (II) methods comprising transforming a plant to decrease the level of expression of non-symbiotic hemoglobin, Applicants hereby elect the subject matter of **Group II** (decreasing). As noted in the Office Action, claims 24, 28 and 30-32 are directed to this subject matter. This election is made with traverse, for the reasons detailed below.

At the outset, Applicants emphasize that no lack of unity finding was made in the PCT application or the EP application upon which the PPH status is based, or in any other corresponding application subject to the PCT unity of invention standards. Thus, the instant claims are believed to satisfy the PCT unity of invention requirements.

Additionally, Applicants note that even for U.S. national stage applications, a restriction requirement under 35 U.S.C. §§121 and 372 is not proper unless examining all of the claims would impose a serious burden on the examiner. Here, there is no showing that the restricted subject matter is subject to separate classification, has attained separate status in the art, or would require a different field of search. Indeed, Applicants earnestly believe that no serious burden would be required to examine the full scope of the pending claims.

The Restriction Requirement is based on the assertion that the claims do not share a single general inventive concept and lack a common or corresponding special technical feature that represents a contribution over the state of the art. In making this assertion, the Action identifies the “technical feature linking group I and II” as being “a method comprising transforming a plant with a sequence encoding non-symbiotic hemoglobin,” and cites teachings in Guy (WO 00/00597) regarding maize cells transformed with non-symbiotic hemoglobin as destroying the novelty of this feature. This analysis incorrectly characterizes the common technical feature, however.

As recited in the claims, and as taught throughout the specification as filed, the present invention is directed to methods of modifying a plant phenotype of a plant grown under normal oxygen conditions, wherein the modified phenotype is selected from the group

consisting of shoot or root apical dominance, flower color, and chlorophyll content. There is no portion of Guy that destroys the novelty of this technical feature and no teaching or suggestion of any methods of modifying a plant phenotype. Accordingly, Applicants urge reconsideration and withdrawal of the Restriction Requirement on this basis.

Alternatively, Applicants respectfully urge that the Restriction Requirement be reclassified as an Election of Species Requirement, which also is permitted under the PCT national phase procedures. See, e.g., MPEP § 1893.03(d). Election of species may be more fitting here, because “[t]his application contains claims directed to more than one species of the generic invention.” An Election of Species, rather than a Restriction Requirement, may be required when the “species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.” MPEP § 1893.03(d), ¶ 18.20. Here, where the two groups identified in the Office Action do fall within the scope of generic claim 24, an election of species requirement, rather than a restriction requirement, would better comport with the rules.

Conclusion

If there are any questions regarding this submission, or if any issues remain, the Examiner is invited to contact the undersigned by telephone in order to advance prosecution.

Respectfully submitted,

Date February 4, 2011

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